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| EXAMINER |
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1661

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/925,696
Filing Date: August 09, 2001
Appellant(s): BENETKA ET AL.

**MAILED
DEC 05 2006
GROUP 1600**

Mark Bourgeois
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 13, 2006 appealing from the Office action mailed May 17, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by each of Australian Plant Varieties Journal, 1998, Volume 11, No. 4, page 49 (also a correction is listed in the Australian Plant Varieties Journal, 1999, Volume 12, No. 4, page 103) as well as the Plant Breeder's Right applications QZ PBR 20000821; AU PBR 1998014 and CZ PBR 0WEI06556 (disclosed in the response to the 1.105 Requirement of October 29, 2004) in light of Appellant's admission the plant was publicly available and the RHS Dictionary of Gardening.

Claim 1 is drawn to a weigela plant named 'Pink Poppet'.

The Australian Plant Varieties Journal 1998, Volume 11, No. 4, page 49, expressly discloses the weigela plant 'Plangen' was first sold in Australia in 1997 under the name of 'Piccolo.' The Australian Plant Varieties Journal, 1999, Volume 12, No. 4, page 103, lists the

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corrected date of sale as "10 Dec 1997." The QZ PBR 20000821 Plant Variety Office document, which states the provisional name of the claimed plant is 'Plangen,' notes that 'Plangen' is also referred to as 'Pink Poppet' and 'Piccolo' (pages 3- 4).

Plant Breeders Right documents such as published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221,226, 210 USPQ 790, 792 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through UPOV. Thus, information regarding the denomination of the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art and the skilled artisan would have known that the plant described in the Plant Varieties Journal article was being marketed under different names in different countries.

One of ordinary skill in the art would have been able to propagate the claimed weigela without undue experimentation given that the method of propagating weigelas was widely known in the art as evidenced by the RHS Dictionary of Gardening, at the bottom of page 702 and top of page 704. Barring evidence to the contrary, the sale of weigela more than a year prior to filing in the U.S. was not a single isolated event. One of ordinary skill in the art would have been able to determine where to buy the plant by contacting the breeder as listed by UPOV.

A printed publication can serve as a statutory bar under 35 U.S.C 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was in public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.")

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. Public availability of the plant, combined with

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knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the claimed plant. Appellant has admitted that the claimed plant was for sale more than one year prior to application for U.S. patent and thus was in the public domain. *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states “When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar” (1041) and “the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available” (1043). Appellant’s admission that ‘Pink Poppet’ was for sale in The Czech Republic in 1995, does not appear to be an obscure or isolated occurrence. Selling to a wholesaler is not obscure or isolated because the purpose of the wholesaler was to increase plants for further commercial production. There is nothing on the record to indicate that Appellant retained control of the invention, e.g. through contractual agreement forbidding propagation and resale of the claimed plant to consumers or other wholesalers. The end result was that the plant was in the public domain as soon as it was conveyed to the wholesaler. Absent evidence of the relationship between the Appellant and the licensed propagator, it is assumed this constituted the first offering to the “public.” It is immaterial whether the public was the wholesaler, retailer, or other parties. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention without undue experimentation. Therefore, the claim is anticipated by each of the Australian Plant Varieties Journal articles as well as the plant breeders’ right QZ PBR 20000821 (European Community) Community Plant Variety Office (disclosed in the response to the 1.105 Requirement of October 29, 2004), CZ PBR 0WEI06556 and AU PBR 1998014 in light of the RHS Dictionary of Gardening that one of skill in the art would have known how to propagate weigela and Appellants’ admission the plant was publicly available.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

Plant Breeder's Right grant number 1325, AU PBR 1998014, granted September 13, 1999;

Plant Breeder's Right application number, 20000821, QZ PBR 20000821;

Plant Breeder's Right grant number, 679, CZ PBR 0WEI06556, granted May 31, 1996;

RHS Dictionary of Gardening, page 702-704;

Appellant's response (October 29, 2004) to the request for information under 37 CFR 1.105 regarding the sale or distribution of the plant anywhere in the world prior to the filing date and if the sale was an obscure solitary occurrence;

Australian Plant Varieties Journal, 1998, Volume 11, No. 4, pages 49-50; and

Australian Plant Varieties Journal, 1999, Volume 12, No. 4, page 103.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by each of Plant Breeder's Right documents AU PBR 1998014, granted September 13, 1999 as grant number 1325; and CZ PBR 0WEI06556, granted May 31, 1996 as grant number 679; and QZ PBR 20000821 Plant Breeder's Right application number, 20000821, and Australian Plant Varieties Journal, 1998, Volume 11, No. 4, pages 49-50; and Australian Plant Varieties Journal, 1999, Volume 12, No. 4, page 103, each published more than one year prior to the filing of the U.S. application. These publications are each rejected in light of Appellant's admission that 'Pink Poppet' was on sale in The Czech Republic as of 1995 and the knowledge on how to propagate the claimed plant as described in the RHS Dictionary of Gardening (pages 702-704). 'Pink Poppet' is the same plant as 'Piccolo' and 'Plangen'.

Claim 1 is drawn to a weigela plant named 'Pink Poppet'.

The cited publications each teach the weigela plant 'Pink Poppet'.

In response to the 105 Requirement for Information, Appellant admits that first sale of the instant plant took place in 1995 in the Czech Republic (response dated October 29, 2004).

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The claimed weigela variety 'Pink Poppet' is described in the Plant Breeder's Rights cited above and published more than one year prior to filing in the U.S.

The published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 792 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through UPOV. Thus, information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

One of ordinary skill in the art would have been able to propagate the claimed weigela without undue experimentation given that the method of propagating weigelas was widely known in the art as evidenced by the RHS Dictionary of Gardening, at the bottom of page 702 and top of page 704.

Barring evidence to the contrary, the sale of weigela more than a year prior to filing in the U.S. was not a single isolated event. One of ordinary skill in the art would have been able to determine where to buy the plant by contacting the breeder as listed by UPOV.

A printed publication can serve as a statutory bar under 35 U.S.C 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was in public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.")

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. Public availability of the plant, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the claimed plant. Appellant has admitted that the claimed plant was for sale more than one year prior to

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application for U.S. patent and thus was in the public domain. *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states “When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar” (1041) and “the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available” (1043). Appellant’s admission that ‘Pink Poppet’ was for sale in The Czech Republic in 1995, does not appear to indicate that the sale was an obscure or isolated occurrence. Selling to a wholesaler is not obscure or isolated because the purpose of a wholesaler is to increase plants for further commercial production. There is no evidence that indicates that the plant would not have been offered to other interested parties. The end result was the plant was in the public domain as soon as it was offered to the wholesaler. Absent evidence of the relationship between the wholesaler and the licensed propagator, it is assumed this constituted the first offering to the “public.” It is immaterial whether the public was the wholesaler, retailer, or other parties. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention without undue experimentation. Therefore, the claim is anticipated by each of the published Plant Breeder’s Rights documents AU PBR 1998014, as grant number 1325; and QZ PBR 20000821 Plant Breeder’s Right application number, 20000821; and CZ PBR 0WEI06556, as grant number 679, Australian Plant Varieties Journal, 1998, Volume 11, No. 4, pages 49-50 and Australian Plant Varieties Journal, 1999, Volume 12, No. 4, page 103.

(10) Response to Argument

Appellant argues (page 10 of brief) that a non-enabling printed publication by itself cannot be cited as prior art under 102(b) and foreign public use alone cannot be cited as prior art under 102(b) and *Ex Parte Thomson* combined these two non-prior art references.

Appellant’s arguments are not persuasive, as the propriety of this type of rejection was recently affirmed by the Court of Appeals for the Federal Circuit. *In re Elsner*, 72 USPQ2d 1038

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(CAFC 2004) states, “However, because the public may have had access to the claimed inventions through the foreign sales of the plants, from which the claimed plants may be reproduced, it may fairly be said that the PBR applications are adequately enabled. Because the published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public, we therefore hold that they are proper 102(b) anticipatory references that may bar patentability” (page 1042). As stated above, Appellant admits that the sale of the claimed cultivar occurred in The Czech Republic in 1995, more than one year before the filing date of the instant application. *Elsner* also states, “Only when possession derived in this manner enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sales act as a 102(b) bar” (page 1041). “The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art” (page 1043). Therefore, each of the published PBR applications and the Australian Plant Varieties Journals combined with accessibility of the foreign sale of the claimed plant, and the knowledge of reproducing a weigela plant as described on the new Royal Horticultural Society Dictionary of Gardening on pages 702-704, would elicit a rejection under 35 U.S.C. 102(b).

Appellant argues (page 11 of brief) that it is doubtful that one skilled in the art who is interested in reproducing ‘Pink Poppet’ would know to go to a foreign country and purchase plants under a different name in order to replicate the plant. Additionally, **Appellant argues** that a plant breeder reading the Plant Breeder’s Rights grant for ‘Plangen’ would attempt to purchase plants of ‘Plangen’ in order to reproduce ‘Plangen.’ Additionally, Appellant argues that a plant breeder reading the Plant Breeder’s Rights grant for ‘Piccolo’ would attempt to purchase plants of ‘Piccolo’ in order to reproduce ‘Piccolo.’ Furthermore, **Appellant argues** a plant breeder reading the Australian or Czech Republic documents would not have knowledge of ‘Pink Poppet’. The sale of ‘Piccolo’ or ‘Plangen’ anywhere in the world does not enable the invention of ‘Pink Poppet.’

This argument has been carefully considered but is not persuasive. If Appellant only had to change a name of an invention to be able to bypass a 102(b) rejection then it would completely undermine Congress’s intent that speedy application for US patent should occur. In this case

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Appellant waited 3 years before filing within the U.S. which is not the intent of 35 U.S.C. 102 that states that applications should be filed within one year of filing in other countries. Does a name change obscure the issue that one of skill in the art would have been able to purchase the plant? Does a name change obscure the issue that the sale was not a single, isolated, occurrence? Does a name change mean that one of the ordinary skill in the art would not have been able to propagate the plant? The Examiner believes that this is not the case for each of the posed interrogatories and the name of the plant is irrelevant. The "how to make" and "use" requirement has been met. One of the ordinary skill in the art would have been able to obtain the plant and make/use the plant based on the previous cited evidence, thus enabling the publication. If all Appellants need to do, is change the name of the plant, then conceivably any plant from overseas could be sold here under a different name and not infringe any intellectual property rights. Moreover, the UPOV-ROM GTITM Computer database lists the breeder and assignee name. For Appellant to state that one of the ordinary skill in the art would be unable to purchase the plant under a different name and not know it was the same plant is not a valid argument. The prior art cited in the rejections above makes clear the fact that the claimed plant was being marketed under different names. Moreover, it is presumed that when contacted by one of the ordinary skill in the art, the breeder, eager to sell, would indicate to the former that the plant is available and sold under another name. It is clear that a difference in names does not obscure the fact that one of ordinary skill in the art could have bought the plant, as the sale was not a single, isolated occurrence, and could have reproduced the plant since asexual reproduction of *Wiegela* is well documented in the art, thus enabling the Plant Breeder's Right grant.

Appellant argues (page 11 of brief) that for the American public to get access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States.

This is not found persuasive because Appellant is reminded that the rejection is over a publication. As a result, the availability need not occur in the United States. Additionally, the customs and quarantine importation procedures have nothing to do with enablement of a publication. One of ordinary skill in the art would have been able to buy the plant as discussed above. **Appellant argues** (page 12 of brief) that propagatable material of the new variety is not

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only essential to enable the invention it is the invention. In the absence of propagatable material, the variety does not exist, nor can it be conjured up from the description in any printed publication, regardless of how detailed or specific. In the absence of any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a mere printed publication, regardless of how detailed it is, and regardless of where it is published.

This is not found persuasive because the issue decided in *Ex parte Thomson* was that if deposit (availability) of the plant enabled the specification, then availability also enabled the publications. It is the availability of the plant cited in *Thomson* that is important, not the description of the plant. In this case, there is no dispute that the PBR publication references the same plant. Additionally, the availability of the claimed weigela plant enables the cited PBR publications. Based solely on the reference, a skilled artisan would have been able to buy a weigela plant named 'Pink Poppet' or 'Plangen' or 'Piccolo' which would have been the exact same weigela plant as described in the application for patent. The Examiner readily admits that the plant cannot be reproduced from a mere printed publication except for the fact that sale of the invention put the invention in the public domain. The publications also list the breeder, title holder and other parties to where the propagatable material could be found simply by searching the Internet. The Examiner agrees that the PBR publications do not meet the standards of a US application for patent, but it do contain the **material elements** necessary to put the invention in the public domain in light of the fact that the plant was available to the public. The rejection is not combining references using motivation, nor is it improperly combining "on sale in the United States" with a publication, rather the sale of the plant is used to show that the publication was "enabled" and that the plant was in possession of the public under 35 U.S.C. 102(b) in keeping with *In re Samour*, 197 USPQ 1 (CCPA 1978); *In re Donohue*, 226 USPQ 619 766 F.2d 531 1985; *In re LeGrice*, 301 F.2d 929, 133 USPQ (CCPA 1962) and *Ex parte Thomson* 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992).

A § 102(b) printed publication can be published and enabled anywhere in the world. It does not matter that the plant is available outside the United States more than one year before the U.S. filing date. The enablement need not occur in the United States.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This Examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, Appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary Examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary Examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,
S. B. McCormick-Ewoldt
November 13, 2006

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:


Anne Marie Grunberg, SPE
AU1638 and 1661



Bruce Campell, SPE
AU1648



George Elliott



Director, Technology Center 1600

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